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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/147,362 03/12/99 CHENEBAUX

D P63163US0

EXAMINER

HM12/1214

JACOBSON PRICE HOLMAN & STERN
400 SEVENTH STREET NW
WASHINGTON DC 20004

PARKIN, J

ART UNIT

PAPER NUMBER

1648.

DATE MAILED:

12/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/147,362

Applicant(s)
Chenebaux, D.M., et al.

Examiner
Jeffrey S. Parkin, Ph.D.

Group Art Unit
1648



X Responsive to communication(s) filed on 12 Mar 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

X Claim(s) 15-30 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) _____ is/are rejected.

Claim(s) _____ is/are objected to.

X Claims 15-30 are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Serial No.: 09/147,362
Applicants: Chenebaux, D., et al.

Docket No.: P63163USO
Filing Date: 03/12/99

Restriction Requirement

Fax Response Pilot for

Written Restriction Requirements

1. In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is (703) 305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Supervisory Patent Examiner, at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. **Please limit the use of this dedicated Fax number to responses to Written Restrictions.**

35 U.S.C. § 371

2. This application was filed under 35 U.S.C. § 371 and is subject to unity of invention pursuant to 35 U.S.C. § 121 and 372. Instruction pertaining to the presentation of alternative chemical or non-chemical species is provided in Annex B of the M.P.E.P. ¶ (f) (refer specifically to pages AI-39, 40, and 49). Multiple compounds in a single claim will be considered to contain unity of invention when the following criteria are fulfilled:

- a. all alternatives have a common property or activity; and
- b. a common structure is present (i.e., a significant structural element is shared by all of the alternatives); or
- c. in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

The M.P.E.P. further defines "recognized class of chemical compounds" to mean that "there is an expectation from the knowledge

in the art that members of the class will behave in the same way in the context of the claimed invention. In other words, each member of the class could be substituted one for the other, with the expectation that the same intended result would be achieved."

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3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack Unity of Invention because they are not so linked as to form a single inventive concept under PCT Rule 13.1. **Applicant is required, in response to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable.** The response must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election. The species are as follows:

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- a. Claims 21 and 22, drawn to different synthetic peptides (e.g., Seq. Nos. 1, 2, 3, 4, etc.).

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4. The species listed above do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: each of the peptides identified above has a different amino acid sequence and lacks a common core structure responsible for the biochemical and immunological activities of any given peptide. Moreover, since it is well-documented in the art that even single amino acid substitutions, additions, or deletions can influence the immunological activities of any given peptide in an unpredictable manner, there is no reasonable expectation that all the peptides will function in the same manner. Moreover, separate searches will also be required for

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each peptide. Accordingly, each of the identified peptides lacks a special technical feature.

5 Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no
10 longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

15 **Correspondence**

6. Correspondence related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Official communications should be
20 directed toward one of the following Group 1600 fax numbers: (703) 308-4242 or (703) 305-3014. Informal communications may be submitted directly to the Examiner through the following fax number: (703) 308-4426. Applicants are encouraged to notify the Examiner prior to the submission of such documents to facilitate
25 their expeditious processing and entry.

7. Any inquiry concerning this communication should be directed to Jeffrey S. Parkin, Ph.D., whose telephone number is (703) 308-2227. The examiner can normally be reached Monday through Thursday from
30 8:30 AM to 6:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner are unsuccessful, the examiner's supervisors, James Housel or Laurie Scheiner, can be reached at (703) 308-4027 or (703) 308-1122, respectively. Any

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Applicants: Chenebaux, D., et al.

inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196.

Respectfully,



Jeffrey S. Parkin, Ph.D.
Patent Examiner
Art Unit 1648

13 December, 2000



RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

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TO EXAMINER:

ART UNIT:

SERIAL NUMBER:

FAX/TELECOPIER NUMBER: (703) 308-4315

**PLEASE NOTE: THIS FACSIMILE NUMBER IS TO BE USED ONLY
FOR RESPONSES TO RESTRICTIONS.**

COMMENTS: _____

IF YOU HAVE NOT RECEIVED ALL THE PAGES OF THIS TRANSMISSION, PLEASE CONTACT THE ATTORNEY AT THE TELEPHONE NUMBER LISTED ABOVE.

IN COMPLIANCE WITH 1096-OG 30, THE FILING DATE ACCORDED EACH OFFICIAL FAX TRANSMISSION WILL BE DETERMINED BY THE FAX MACHINE DATE STAMP FOUND ON THE LAST PAGE OF THE TRANSMISSION, UNLESS THAT DATE IS A SATURDAY, SUNDAY, OR FEDERAL HOLIDAY WITHIN THE DISTRICT OF COLUMBIA, IN WHICH CASE THE OFFICIAL DATE OF RECEIPT WILL BE THE NEXT BUSINESS DAY.

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